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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/828,330 03/28/97 MORGAN

W I-852-002

EXAMINER

PM82/0726

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ART UNIT

PAPER NUMBER

3635

DATE MAILED:

07/26/01

Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 28

Application Number: 08/828330
Filing Date: 03/28/97
Appellant(s): William D. Morgan

MAILED

JUL 26 2001

GROUP 3600

N. Paul Friederichs
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 06/13/01.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

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(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that all claims stand or fall together.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

Note that the Appendix also lists allowed claims 1-3.

(9) *Prior Art of Record*

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 4-12, 14-16 and 18-48 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon

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which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

In claim 4 the limitation of the cable disposed through the entire row of loops has been omitted.

In claims 5-12, 14-16 and 18-48 many of the limitations recited in the reasons for allowance have been omitted.

The examiner included these limitations in his reasons for allowance in paper #2 mailed 09/12/94 of the patented file. Applicant failed to present a counter statement or comment as to the examiner's reasons for allowance, and permitted the claim to issue. The omitted limitations are thus established as relating to subject matter previously surrendered.

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(11) Response to Argument

Applicant argues that there is no evidence of surrendered subject matter.

It is the examiner's position that applicant's failure to provide a counter statement or comment on the reasons for allowance is evidence of surrender.

The claims were presented. The examiner reviewed the claims and issued a reasons for allowance.

The examiner's reason for allowance recites "no prior art of record teaches or fairly suggests, alone or in combination, a cover having plurality of panel units connected together in a vertical spaced relationship at their ends, a plurality of grommets disposed at the connected ends, a cable disposed through each the grommets and formed into a loop projecting above the panel units, and a cable disposed through the entire row of loops".

The "alone or in combination" refers to the prior art.

The reasons for allowance clearly states that it is the combination of:

- A) plurality of panel units connected together in a vertical spaced relationship at their ends,
 - B) a plurality of grommets disposed at the the connected ends,
 - C) a cable disposed through each the grommets and formed into a loop projecting above the panel units, and
 - D) a cable disposed through the entire row of loops,
- which was found o be allowable.

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It is the examiner's position that each and every one of elements A-D must be present in each claim of the instant reissue application.

Applicant failed to provide a counter statement or comment and permitted the claims to issue.

Applicant argues that there was no cancellation of claims, argument or other file history made in an effort to overcome a prior art rejection so no surrender occurred.

It is the examiner's position that applicant's silence to the reasons for allowance amounts to an admission and that any claim omitting any of limitations A-D is thus established as relating to subject matter previously surrendered.

In view of recent case law dealing with prosecution history, failure of applicant to comment on reasons for allowance gives rise to a presumption of acquiescence to those reasons. See, e.g., Warner-Jenkinson Co. V. Hilton Davis Chem. Co., 117 S. Ct. 1040, 41 USPQ2d 1865 (1997); Markman v. Westview Instruments, 52 F. 3d 967, 34 USPQ2d 1321 (Fed. Cir. 1995), aff'd 166 S Ct. 1384, 38 USPQ2d 1461 (1996); Vitronics Corp. V. Conceptronic Inc., 90 F.3d 1576, 39 USPQ2d 1573 (fed.Cir.1996).

As such it is believed that the recapture rejection of claims 4-12, 14-16 and 18-48 should be maintained.

Respectfully,

Robert Canfield

July 25, 2001



Conferees:

M.S.

L.C.

Robert Canfield
Primary Examiner